



THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE B

APPLICANT: Wever, et al. DOCKET NO: P99,0886
 SERIAL NO.: 09/308,478 ART UNIT: 2123
 FILED: May 17, 1999 EXAMINER: D. Sergent
 TITLE: Computer Assisted Method for Partitioning an Electric Circuit

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JUN 27 2001

Assistant Commissioner for Patents,
Washington, D.C. 20231

Dear Sir:


Technology Center 2100

This reply is responsive to the Office Action, Paper 5, dated May 24, 2001 and a telephone with the Examiner on May 31, 2001.

After reviewing the above-identified Office Action, Applicants realized that the Examiner did not have the preliminary amendment filed in the case during his review. Applicants have concurrently filed a Petition to Consider Correspondence Filed (copy attached) so that the Preliminary Amendment will be of record in the present case prior to a first office action on the merits.

Applicants respectfully request that once the petition has been granted, the Preliminary Amendment be entered and a new/replacement office action provided in place of Paper 5.

Respectfully submitted,


 (Reg. No. 45,877)
 Mark Bergner
 SCHIFF HARDIN & WAITE
 PATENT DEPARTMENT
 6600 Sears Tower
 Chicago, Illinois 60606-6473
 (312) 258-5779
 Attorney for Applicants
 Customer Number 26574



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on June 20, 2001.

5


Mark Bergner Attorney for Applicants

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JUN 27 2001

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CERTIFICATE OF MAILING BY EXPRESS MAIL

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Date of Deposit: May 17, 1999

I hereby certify that this correspondence is being deposited with the United States Postal "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10(c) on the date indicated above and is addressed to:

BOX PCT
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Case Number: P99,0886

International Application No.
PCT/DE97/02600

International Filing Date
November 11, 1997

Priority Date Claimed
November 18, 1996

Title: "COMPUTER SUPPORTED METHOD FOR PARTITIONING AN
ELECTRICAL CIRCUIT"

Applicants: Utz Wever, et al.

Enclosed are the following documents:

PTO Form 1390 in duplicate
PCT Request Form
Translation of International Application into English
Submission of Drawings (2 sheets - Figs. 1-2)
Executed Declaration and Power of Attorney
Executed Assignment (in separate envelope with \$40.00 recording fee)

Fee: \$970.00

Postcard

Signature of person mailing document and fees



COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOX DAC

PETITION TO CONSIDER CORRESPONDENCE FILED IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE UNDER 37 CFR 1.10

APPLICANT:	Wever, et al.	DOCKET NO:	P99,0886
SERIAL NO.:	09/308,478	ART UNIT:	2123
FILED:	May 17, 1999	EXAMINER:	D. Sergent
TITLE:	Computer Assisted Method for Partitioning an Electric Circuit		

RECEIVED

Commissioner of Patents and Trademarks,
Washington, D.C. 20231

JUN 27 2001

Dear Sir:

Technology Center 2100

Applicants file this petition pursuant to 37 CFR 1.10(e).

Statement of Facts

Applicants received an Office Action, Paper 5, dated May 24, 2001 which indicated that the preliminary amendment filed with the U.S.P.T.O. had not been received. A conversation with the Examiner on May 31, 2001 confirmed that this was the case.

The above-identified Preliminary Amendment (attached) was originally filed (along with the PCT Application, an Executed Declaration, Assignment, and Power of Attorney, Translation, and Submission of Drawings) with the United States Patent and Trademark Office on May 17, 1999.

Receipt by the U.S.P.T.O is evidenced by the following copies attached to this petition:

1. Express Mail Label Number EL294310959US;
2. The postcard received from the U.S.P.T.O identifying that a preliminary amendment had been received; and
3. The Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 indicating receipt of a Preliminary Amendment.

The original deposit of the correspondence and the copies of the correspondence contained herein are identical. The copy of the Express Mail mailing label and the official notation entered by the USPS are true copies.

Applicants have filed this petition promptly after an awareness that the Office did not receive the above-noted correspondence. Since the loss of the Preliminary Amendment appears to be the fault of the U.S.P.T.O., applicants believe that no fee is due.

APPLICANT HEREBY PETITIONS THAT:

- 1) THE PRELIMINARY AMENDMENT SUBMITTED WITH THIS PETITION

BE CONSIDERED AS FILED IN THE OFFICE ON THE USPS DEPOSIT DATE OF MAY 17, 1999; AND

2) A NEW/REPLACEMENT OFFICE ACTION BE PROVIDED THAT TAKES INTO ACCOUNT THIS PRELIMINARY AMENDMENT AND THAT THE PERIOD OF RESPONSE BE BASED UPON THIS NEW/REPLACEMENT OFFICE ACTION.

Applicants believe that all requirements have been met with this petition, and respectfully request that the petition be granted.

It is believed that no fee is required for this petition; however, if the Commissioner finds that an additional fee is due, the Commissioner is authorized to charge any such fees to account no. 50-1519.

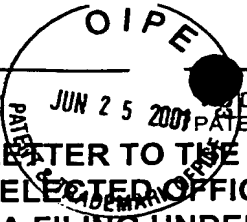
Respectfully submitted,

Mark Bergner (Reg. No. 45,877)
Mark Bergner
SCHIFF HARDIN & WAITE
PATENT DEPARTMENT
6600 Sears Tower
Chicago, Illinois 60606-6473
(312) 258-5779
Attorney for Applicants
Customer Number 26574

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on June 20, 2001.

Mark Bergner
Attorney for Applicants



DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTORNEYS DOCKET NUMBER
P99,0886

**TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371**

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)

INTERNATIONAL APPLICATION NO.
PCT/DE97/02600

INTERNATIONAL FILING DATE
November 11, 1997

PRIORITY DATE CLAIMED
November 18, 1996

TITLE OF INVENTION **COMPUTER-SUPPORTED METHOD FOR PARTITIONING AN ELECTRICAL CIRCUIT**

APPLICANT(S) FOR DO/EO/US **UTZ WEBER and GINGHUS ZHENG**

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☒ This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay.
4. ☐ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☒ A copy of International Application (35 U.S.C. 371(c)(2))
 - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
 - b. ☒ has been transmitted by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US)
6. ☒ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. §371(c)(3))
 - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
 - b. ☐ have been transmitted by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☐ have not been made and will not be made.
8. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)) (**attached at back of English translation of application**).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
10. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11. to 16. below concern other document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 C.F.R. 1.97 and 1.98; (**PTO 1449, Prior Art, Search Report**).
12. ☒ An assignment document for recording. A separate cover sheet in compliance with 37 C.F.R. 3.28 and 3.31 is included.
(SEE ATTACHED ENVELOPE)
13. ☒ A **FIRST** preliminary amendment.
☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☒ Other items or information:
 - a. ☒ Submission of Drawings
 - b. ☐ Letter Under Rule Under 37 C.F.R. §1.41(c)
 - c. ☒ EXPRESS MAIL #EL294310959US

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BEST AVAILABLE COPY

17. ☒ The following fees are submitted:**BASIC NATIONAL FEE (37 C.F.R. 1.492(a)(1)-(5):**

Search Report has been prepared by the EPO or JPO \$970.00

International preliminary examination fee paid to USPTO (37 C.F.R. 1.482) ... \$760.00

No international preliminary examination fee paid to USPTO (37 C.F.R. 1.482) but
international search fee paid to USPTO (37 C.F.R. 1.445(a)(2)) \$450.00Neither international preliminary examination fee (37 C.F.R. 1.482) nor international
search fee (37 C.F.R. 1.445(a)(2)) paid to USPTO \$1,250.00International preliminary examination fee paid to USPTO (37 C.F.R. 1.482) and all
claims satisfied provisions of PCT Article 33(2)-(4) \$ 98.00**ENTER APPROPRIATE BASIC FEE AMOUNT =**

CALCULATIONS

PTO USE ONLY

\$ 970.00

Surcharge of \$130.00 for furnishing the oath or declaration later than ☐ 20 ☐ 30 months from
the earliest claimed priority date (37 C.F.R. 1.492(e)).

\$

Claims

Number Filed

Number
Extra

Rate

Total Claims

9

- 20 =

X \$ 22.00

\$

Independent Claims

1

- 3 =

X \$ 82.00

\$

Multiple Dependent Claims

\$270.00 +

\$

TOTAL OF ABOVE CALCULATIONS =

\$ 970.00

Reduction by 1/2 for filing by small entity, if applicable. Verified Small Entity statement must also
be filed. (Note 37 C.F.R. 1.9, 1.27, 1.28)

\$

SUBTOTAL =

\$ 970.00

Processing fee of \$130.00 for furnishing the English translation later than ☐ 20 ☐ 30 months
from the earliest claimed priority date (37 CFR 1.492(f)).

+

\$

TOTAL NATIONAL FEE =

\$

Fee for recording the enclosed assignment (37 C.F.R. 1.21(h). The assignment must be
accompanied by an appropriate cover sheet (37 C.F.R. 3.28, 3.31). \$40.00 per property

+

**SEE
ATTACHED
ENVELOPE****TOTAL FEES ENCLOSED =**

\$ 970.00

Amount to be
refunded

\$

charged

\$

a. ☒ A check in the amount of \$ 970.00 to cover the above fees is enclosed.b. ☐ Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees. A
duplicate copy of this sheet is enclosed.c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any
overpayment to Deposit Account No. 08-2290. A duplicate copy of this sheet is enclosed.**NOTE:** Where an appropriate time limit under 37 C.F.R. 1.494 or 1.495 has not been met, a petition to revive (37 C.F.R. 1.137(a) or (b)) must
be filed and granted to restore the application to pending status.**SEND ALL CORRESPONDENCE TO:**Hill, Steadman & Simpson
A Professional Corporation
85th Floor Sears Tower
Chicago, Illinois 60606**SIGNATURE**

Steven H. Noll

NAME

29,982

Registration NumberRECEIVED
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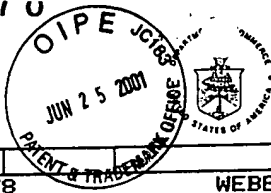
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Hill & Simpson

CHECK DATE: 05-17-99

CHECK NO.: 71507

DATE	INVOICE	VOUCHER	COMMENTS	NET		
05-17-99	051799	14624	SIEMENS P99,0886	840.00		
VENDOR: COMMISSIONER OF PATENTS & TRADEMARKS REF #					TOTAL	\$ 840.00



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

U.S. APPLICATION NO. 09/308,478 FIRST NAMED APPLICANT WEBER U ATTY. DOCKET NO. P99,0886

HILL STEADMAN & SIMPSON
85TH FLOOR SEARS TOWER
CHICAGO IL 60606

5611

INTERNATIONAL APPLICATION NO.

PCT/DE97/02600

I.A. FILING DATE

PRIORITY DATE

11/07/97

11/18/96

06/25/99

DATE MAILED:

NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371
AND 37 CFR 1.494 OR 1.495

1. The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as ☐ a Designated Office (37 CFR 1.494), ☒ an Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is **ACCEPTED** for national patentability examination in the United States Patent and Trademark Office.

2. The United States Application Number assigned to the application is shown above and the relevant dates are:

17 MAY 1999

35 U.S.C. 102(e) DATE

17 MAY 1999DATE OF RECEIPT OF
35 U.S.C. 371 REQUIREMENTS**RECEIVED**

JUN 27 2001

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE OF RECEIPT OF THE FILING RECEIPT AS THE "FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371(C) REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363). Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

3. ☒ request for immediate examination under 35 U.S.C. 371(f) was received on **17 MAY 1999** and the application will be examined in turn.

4. The following items have been received:

- ☒ U.S. Basic National Fee.
- ☒ Copy of the international application in:
 - ☒ non-English language.
 - ☐ English.
- ☒ Translation of the international application into English.
- ☒ Oath or Declaration of inventors(s) for DO/EO/US.
- ☐ Copy of Article 19 amendments. ☐ Translation of Article 19 amendments into English.
 - The Article 19 amendments ☐ have ☐ have not been entered.
- ☒ The International Preliminary Examination Report in English and its Annexes, if any.
- ☐ Copy of the Annexes to the International Preliminary Examination Report (IPER).
 - ☐ Translation of Annexes to the IPER into English.
 - The Annexes ☐ have ☐ have not been entered.
- ☒ Preliminary amendment(s) filed _____ and _____.
- ☐ Information Disclosure Statement(s) filed _____ and _____.
- ☒ Assignment document.
- ☐ Power of Attorney and/or Change of Address.
- ☐ Substitute specification filed _____.
- ☐ Statement Claiming Small Entity Status.
- ☒ Priority Document.
- ☒ Copy of the International Search Report ☐ and copies of the references cited therein.
- ☒ Other: *Certificate of Express Mailing; R0101; ISA 220*

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

Franchise Young
National Stage Processing
Telephone: (703) Paralegal Specialist
(703) 305-3662



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HON. COMMISSIONER OF PATENTS & TRADEMARKS
WASHINGTON, D.C. 20231

SIR:

PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

Utz Wever, et al.

APPLICANT

PCT appln., exec. Decln., translation
Preliminary Amendment, Submission of
Drawings (2 sheets-Figs. 1-2), Request

~~8840~~ TYPE OF DOCUMENT(S)

~~\$970~~ filing fee

P99,0886

May 17, 1999

MAILING DATE

#1084 (Siemens #0289)

REFERENCE NUMBER

based on PCT/DE97/02600

512 Rec'd PCT/PTO 17 MAY 1999
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A PROFESSIONAL CORPORATION

Form 20R

09/308478



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Date In 5/17/99	Postage \$ 15.71
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HILL & SIMPSON
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CHICAGO IL 60606-6306
#1084 (Siemens P99,0886)

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